Remarks

Applicants have canceled claims 2-8, without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation applications. Claim 12 has been amended and claims 13-23 have been added. Support for the amendment to claim 12 and new claims 13-23 can be found in the specification, for example, at page 18, paragraph [0056] (glycosylated); page 18, paragraph [0060] and page 24, paragraph [0079] (fusion protein); page 21, paragraph [0069] and page 23, paragraph [0077] (fragments); Thus, no new matter has been added.

Upon entry of the present amendments, claims 1, and 9-23 will be pending.

Provisional Election With Traverse

The Examiner has issued a restriction requirement separating pending claims 1-12 into 10 groups. *See*, Paper No. 04192004, pages 2-3. To comply with the pending election requirement, Applicants herein provisionally elect, *with traverse*, Group 4, drawn to an isolated I-FLICE-2 (i.e., claim 9). Applicants respectfully traverse the present election requirement.

Applicants respectfully submit that the Examiner has not demonstrated that there would be a serious burden to examine the subject matter of all of the Groups, in particular, all of the groups directed towards I-FLICE-2 (*See*, M.P.E.P. § 803.02). The Examiner merely states that inventions of groups 1-6 are "unrelated" because the claims are directed towards products such as a polynucleotide, polypeptide and antibody, which differ with respect to their structure, and physiochemical properties (Paper No. 04192004).

Applicants submit that to search and examine the subject matter of all the Groups together, and in particular, to search Groups 2, 4, 6, 8 and 10 simultaneously, would not entail a serious burden. A search of the amino acid sequence of I-FLICE-2 would surely produce information relevant to the nucleic acid sequence of I-FLICE-2, and antibodies that bind to I-FLICE-2

However, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Group 8 once the claims of Group 6 are found allowable. In light of the decisions in In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the

Official Gazette which set forth new guidelines for the treatment of product and process claims. *See* 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

> in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Id. Accordingly, if claims of Group 6 are found allowable, Applicants respectfully request that the claims of Group 8 be rejoined and examined for patentability. *See* also M.P.E.P. § 821.04.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date: May 7, 2004

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